

Applicant : Andreas N. Wiswesser et al.
Serial No. : 10/616,488
Filed : July 8, 2003
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Attorney's Docket No.: 05542-369003 / 2562C2/CMP

REMARKS

Claims 22-30 and 38-47 were pending, of which claim 22 is independent. Claims 22, 23, 26-30, 38-40, and 42-47 stand rejected. Claims 24, 25, and 41 are objected to but would be allowable if rewritten to independent form. The applicant amended claims 22, 25, 26, 29, and 38-40 and canceled without prejudice claims 23 and 24. Claims 22, 25-30, and 38-47 are now pending. The applicant respectfully requests reconsideration in view of the amendments and following remarks.

Section 103 Rejections

Claims 22-23, 26-30, 38-39, 40, 42-43, and 47 stand finally rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent No. 5,486,129 to Sandhu et al. ("Sandhu") in view of U.S. Patent No. 5,838,447 to Hiyama et al. ("Hiyama"). Claims 44-46 stand finally rejected under 35 U.S.C. Section 103(a) as being unpatentable over Sandhu in view Hiyama and further in view of Japanese Publication No. 403234467.

The applicant respectfully traverses the rejections because finality is improper. M.P.E.P. Section 706.07(b) provides that "it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search . . ." In the case at hand, the applicant submitted an amendment after final rejection, and the Examiner, in the advisory action of June 10, 2005, denied entry of the amendment contending that the amendment raised new issues. Thus, the applicant respectfully submits that finality of the Office action being addressed, which is a first action in a continuing application, is improper.

To expedite prosecution, however, the applicant amended claim 22 to incorporate the limitations of claim 23 and 24, which the Examiner indicated would be allowable. For at least the reason that claim 24 is allowable, the applicant respectfully submits that claim 22 and its dependent claims should be allowed.

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Conclusion

By responding in the foregoing remarks only to particular positions taken by the Examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

Please apply the one-month extension of time fee in the amount of \$120.00 and any other required charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: Jan. 6, 2006



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